

REMARKS

By this Amendment, Applicant amends claims 3, 13, 14, and 16 to more appropriately define the present invention. Claims 1-16 remain pending.

In the Office Action dated June 23, 2003, the Examiner rejected claims 3, 4, 12-14, and 16 under 35 U.S.C. § 112, second paragraph as being indefinite; rejected claim 5 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,066,181 to *DeMaster*; rejected claims 1-4 and 13-16 under 35 U.S.C. § 103(a) as being unpatentable over *DeMaster* in view of U.S. Patent No. 6,369,725 to *Busaba*; and rejected claims 6-11 under 35 U.S.C. § 103(a) as being unpatentable over *DeMaster* in view of "Code Complete: A Practical Handbook of Software Construction" by Steve McConnell ("*McConnell*"). Applicant submits that the rejections should be withdrawn for the reasons discussed below.

Rejection of claims 3, 4, 12-14, and 16 under 35 U.S.C. § 112, second paragraph:

Applicant submits that claims 3, 13, 14, and 16, as amended herein, are fully compliant with 35 U.S.C. § 112, second paragraph. Applicant therefore requests withdrawal of the rejection of claims 3 (and dependent claim 4), 13, 14, and 16.

With regard to claim 12, the Examiner alleged that "[i]t is not clear...what exactly a work space parameter is" (Office Action, page 2). Applicant reminds the Examiner that "[t]he essential inquiry pertaining to [the]...requirement [of definiteness] is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity." M.P.E.P. § 2173.02 (8th ed. 2001). Despite the Examiner's allegation, Applicant submits that the subject matter defined by claim 12 is set forth with a reasonable degree of clarity and particularity. A skilled artisan would be apprised of the scope of claim 12 from the claim language itself and the supporting disclosure. Applicant reminds the Examiner that "[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though

the claim language is not as precise as the examiner might desire." M.P.E.P. § 2173.02 (8th ed. 2001). As claim 12 is fully compliant with 35 U.S.C. § 112, 2nd paragraph, Applicant requests withdrawal of the rejection.

Rejection of claim 5 under 35 U.S.C. § 102(e)

Applicants submit that claim 5 is not anticipated by *DeMaster*. In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(b), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the...claim." See M.P.E.P. § 2131 (8th Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th Ed. 2001), p. 2100-69.

Claim 5 recites a combination of steps including:

source code with a subprogram having at least one of an integer and logical parameter;

an interface generator that reads the subprogram and that generates an interface file with indications of characteristics of the parameter; and

a stub generator that reads the interface file and that generates a stub for the subprogram by using the characteristics, wherein each of the stubs receives a set of parameter values, generates the values for the required parameters from the received set of parameter values, and invokes the subprogram with the values for the parameters.

DeMaster fails to teach at least the above claimed steps. *DeMaster* describes a "Java native interface code generator" that enables "native code programmed in a native language [to be] accessible to Java application programs" (Abstract). In the *DeMaster* system, "the native code 124 is...called from a Java application 140" (col. 4, lines 7-8). In rejecting claim 5, the

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Examiner alleges that native code 124 anticipates the "source code with a subprogram having at least one of an integer and logical parameter" recited in claim 5. However, the Examiner provides no evidence or reasoning to support this allegation. *DeMaster* merely mentions that native code 124 is programmed in a native language (col. 4, lines 1-19).

Moreover, contrary to the Examiner's position, *DeMaster* does not teach at least "an interface generator that reads the subprogram and that generates an interface file with indications of characteristics of the parameter," as claimed. Instead, the relied-upon portion of the reference (col. 2, lines 10-21) merely mentions that "[a] programmer initially generates a native interface definition for native code."

In addition, *DeMaster* does not anticipate at least the stub generator recited in claim 5. The relied-upon portion of the reference mentions that "data conversion stubs...convert and map the native data and functions between the native language and Java" (col. 2, lines 41-43). The stub generator recited in claim 5 generates stubs which receive a set of parameter values, generate the values for the required parameters from the received set of parameter values, and invoke the subprogram with the values for the parameters. The Examiner fails to show that the code generator described by *DeMaster* is consistent with Applicant's claimed stub generator. Indeed, Applicants submit that *DeMaster* fails to teach at least this claimed element.

As set forth above, anticipation under 35 U.S.C. § 102(e) requires that each and every claim element be identically disclosed in as complete detail as is in the claim by the applied reference. *DeMaster* does not teach each and every feature of independent claim 5 and therefore, as a matter of law, cannot anticipate this claim. Thus, Applicant requests withdrawal of the rejection of independent claim 5 under 35 U.S.C. § 102(e) as anticipated by *DeMaster* and the timely allowance of this pending claim.

Rejection of claims 1-4 and 13-16 under 35 U.S.C § 103(a)

Applicant submits that a *prima facie* case of obviousness has not been established with respect to claims 1-4 and 13-16. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001).

With regard to independent claim 1, the Examiner concedes (Office Action, page 4) that *DeMaster* fails to disclose "...generating a stub routine that converts at least one of the integer and logical parameters from 32-bit to 64-bit...", as claimed. In rejecting Applicant's claims, the Examiner relies on *Busaba* in an attempt to cure the above deficiencies of *DeMaster*. According to the Examiner, it would have been obvious to combine *Busaba* with *DeMaster* because "this allows programs written in a 32-bit addressing scheme to access a 64-bit system without rewriting the source code" (Office Action, page 4). Applicant submits that a *prima facie* case of obviousness has not been established for the following reasons.

Initially, Applicant submits that *Busaba* is nonanalogous art and therefore an improper reference against the present application under 35 U.S.C. § 103(a). *Busaba* is not in the same field of endeavor as Applicant's claimed invention. *Busaba* is not reasonably pertinent to the particular problem that the present application addresses. That is to say, *Busaba*, which is directed to binary to decimal conversion, would not logically have commended itself to an inventor's attention in considering the problems associated with adapting source code written for

32-bit addressing models to other address spaces. Accordingly, *Busaba* is to be regarded as nonanalogous art and should not be used as a reference against the present application under 35 U.S.C. § 103(a).

Busaba's status as an improper reference under 35 U.S.C. § 103(a) notwithstanding, *Busaba* fails to cure the deficiencies of *DeMaster*. *Busaba* describes a system for "converting a number from binary to decimal" (Abstract). The relied-upon portion of *Busaba* (col. 2, lines 8-14) mentions converting "a 32-bit binary number into a 64-bit decimal number [and converting] a 64-bit binary number into a 128-bit decimal number." Despite the Examiner's allegations, Applicant submits that *Busaba* fails to cure the above deficiencies of *DeMaster*. Performing a binary to decimal conversion, as described by *Busaba*, is not consistent with converting "at least one of [an]...integer and logical parameter...from 32-bit to 64-bit..." as recited in claim 1. The Examiner provides no explanation or reasoning to support the conclusory statement that the above-noted portion of *Busaba* is consistent with Applicant's claimed features. For at least the foregoing reasons, a *prima facie* case of obviousness has not been established.

Moreover, Applicant reminds the Examiner that determinations of *prima facie* obviousness must be supported by a finding of "substantial evidence." See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Specifically, unless "substantial evidence" found in the record supports the factual determinations central to the issue of patentability, including motivation, the rejection is improper and should be withdrawn.

In this case, there is no "substantial evidence" in the record to support the attempted combination of *DeMaster* and *Busaba*; and, furthermore, the requisite "clear and particular" motivation required to support a *prima facie* case of obviousness is lacking. The Examiner points to no evidence supporting the assertion that a skilled artisan having *DeMaster* before him

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

would have been motivated to combine the reference with *Busaba* in a manner resulting in Applicant's claimed invention. The Examiner merely provides a general description of how *Busaba* allegedly teaches certain features, but that description fails to provide more than conclusory statements, lacking evidentiary basis, to support a motive for combining *Busaba* with *DeMaster* in a manner resulting in Applicant's claimed combination. For example, as noted above, the Examiner alleges that a skilled artisan would have combined the references "since this allows programs written in a 32-bit addressing scheme to access a 64-bit system without rewriting the source code." This statement is not supported by "substantial evidence" on the record, as the Examiner points to no evidence in *DeMaster* or *Busaba* mentioning any such capability or use thereof. Indeed, neither *DeMaster* nor *Busaba* mentions allowing "programs written in a 32-bit addressing scheme to access a 64-bit system without rewriting the source code." Applicant reminds the Examiner that the requirements for establishing a *prima facie* case of obvious must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001). Further, the Examiner fails to provide any explanation or reasoning to show how combining the references would yield the supposed capability.

Applicant submits that a skilled artisan would only arrive at the present claimed invention by consulting Applicant's disclosure. *DeMaster* does not disclose or suggest at least "...generating stub routine that converts at least one of the integer and logical parameters from 32-bit to 64-bit..." as recited in claim 1. And the cited portion of *Busaba* merely mentions a binary to decimal conversion. Therefore, realization of Applicant's claimed invention using the cited references would require reliance on aspects related to the present invention. Such reliance, however, constitutes improper hindsight reasoning.

Thus, even if *Busaba* were a proper reference and disclosed the features so alleged by the Examiner, (Applicant disputing both notions), a *prima facie* case of obviousness has not been established with respect to claim 1. Applicant therefore deems claim 15 patentable over the applied prior art.

Similar to claim 1, independent claim 3 recites a combination of steps, including: "automatically generating a 32-bit to 64-bit conversion stub that is used by the 32-bit source code to invoke 64 bit code." The Examiner concedes that *DeMaster* fails to teach "converting from 32-bit to 64-bit (Office Action, page 5). The Examiner relies on *Busaba* in an attempt to cure the deficiencies of *DeMaster*. For at least the reasons presented above in connection with claim 1, a *prima facie* case of obviousness has not been established with respect to claim 3.

Independent claims 13 and 16 were rejected "for the same reasons as" claim 3 (Office Action, page 5). Claims 13 and 16 are, however, patentable for at least the reasons presented above in connection with claims 1 and 3.

With regard to independent claim 15, Applicant submits that the rejection is ambiguous and does not afford Applicant the opportunity to properly evaluate the basis for the rejection. The Examiner states that claim 15 is "rejected for the same reasons as claim 1" (Office Action, page 4). Claim 15 recites, *inter alia*: "generating a stub routine that invokes the subprogram and that facilitates use of at least one of a converted integer and logical parameter." From the statements on the record, Applicant cannot discern how the Examiner is applying *Busaba* to claim 15. Moreover, Applicant cannot discern to which elements of claim 15, if any, the Examiner is applying *DeMaster*. For these reasons, Applicant requests that the Examiner withdraw the rejection of claim 15. And if the Examiner continues to dispute the patentability of

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

the pending claims, Applicant requests a new non-final Office Action, including clarification as to the grounds of rejection.

Applicant submits that a *prima facie* case of obviousness has not been established with respect to claim 15 at least because the Examiner failed to show that either *DeMaster* or *Busaba* (or any combination thereof) teaches or suggests each and every feature recited in claim 15.

Indeed, Applicant submits that claim 15 is patentable over the applied prior art.

Claims 2 depends from allowable base claim 1, claim 4 depends from allowable base claim 3, and claim 14 depends from allowable base claim 13. Claims 2, 4, and 14 are allowable at least by virtue of such dependency. Applicants request withdrawal of the rejection under 35 U.S.C. § 103(a) and the timely allowance of claims 1-4 and 13-16.

Rejection of claims 6-11 under 35 U.S.C § 103(a)

I. Regarding the McConnell reference

In order to maintain a rejection under 35 U.S.C. § 103(a), the references used to make the rejection must qualify as prior art. Applicants submit that *McConnell* does not qualify as prior art. The *McConnell* reference appears to be a printout of an Internet file, presumably extracted from a larger work. The document refers to a book which appears to claim a copyright date of 1993. To the extent the Examiner is applying *McConnell* as a "printed publication," the Examiner is respectfully reminded that a publication cannot be relied upon as prior art under if it does not include a publication date or retrieval date. Unless the Examiner produces the requisite proof of *McConnell*'s dissemination and publication prior to Applicants' filing date (See M.P.E.P. § 2128), *McConnell* is not a competent prior art reference within the context of 35 U.S.C. § 103 and cannot be used in combination with *DeMaster* to reject Applicant's claims.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNN LLP
1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

II. Claims 6-11 are allowable

Claims 6-11 are patentable at least by virtue of the respective dependence from allowable base claim 5. Moreover, Applicant submits that a *prima facie* case of obviousness has not been established with respect to claims 6-11.

As described above, *McConnell* is not a proper reference within the context of 35 U.S.C. § 103(a) and therefore cannot properly be combined with *DeMaster*. For at least this reason, the rejection of claims 6-11 should be withdrawn.

With regard to claim 6, the Examiner concedes that *DeMaster* fails to teach "that the source code contains comments indicating the characteristics of the parameter" (Office Action, page 6). In rejecting the claim, the Examiner relies on *McConnell* in an attempt to cure the deficiencies of *DeMaster*. According to the Examiner, a skilled artisan would have combined *McConnell* with *DeMaster* "since this allows for better understanding of the parameters of the source code" (Office Action, page 6). Applicant submits that a *prima facie* case of obviousness has not been established with respect to claims 6 for at least the following reasons.

To begin with, the Examiner provides no evidence to support the conclusory statement that *McConnell* teaches "commenting code, wherein the comments include characteristics of the parameter" (Office Action, page 6). Further, Applicant reminds the Examiner that determinations of *prima facie* obviousness must be supported by a finding of "substantial evidence." See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Specifically, unless "substantial evidence" found in the record supports the factual determinations central to the issue of patentability, including motivation, the rejection is improper and should be withdrawn.

Even if *McConnell* were available as prior art and did disclose the features alleged by the Examiner (to which Applicant does not acquiesce), there is no "substantial evidence" in the record to support the alleged combination of *DeMaster* and *McConnell* and the requisite "clear

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

and particular" motivation required to support a *prima facie* case of obviousness is lacking. The Examiner points to no evidence supporting the assertion that a skilled artisan having *DeMaster* before him would have been motivated to combine the reference with *McConnell* in a manner resulting in Applicant's claimed invention. The Examiner merely provides a general description of how *McConnell* allegedly teaches certain features, but that description fails to provide more than conclusory statements, lacking evidentiary basis, to support a motive for combining *McConnell* with *DeMaster* in a manner resulting in Applicant's claimed combination. For example, as noted above, the Examiner alleges that a skilled artisan would have combined the references "since this allows for better understanding of the parameters of the source code." This statement is not supported by "substantial evidence" on the record, as the Examiner points to no evidence mentioning any such "better understanding." Applicant reminds the Examiner that the requirements for establishing a *prima facie* case of obvious must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001). Further, the Examiner fails to provide any explanation or reasoning to show how combining the references would yield the supposed "better understanding."

For at least the foregoing reasons, a *prima facie* case of obviousness has not been established with respect to claim 6.

With regard to claims 7, 10, and 11, a *prima facie* case of obviousness has not been established at least because the Examiner failed to show that the cited references teach or suggest all of the claimed features. Applicant traverses the Examiner's Official Notice regarding the elements of claims 7, 10, and 11. Under the provisions of M.P.E.P. § 2144.03, the procedures set forth in the Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy dated February 21, 2002, and the precedents provided in *Dickinson v. Zurko*, 527 U.S.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970), an Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. Further, any facts asserted as well-known should serve only to "fill in the gaps" in an insubstantial manner. It is never appropriate to rely solely on "common knowledge" without evidentiary support in the record as the principal evidence upon which a rejection is based.

Applicants submit that the elements of claims 7, 10, and 11 are not unquestionably well-known, and the Examiner has failed to demonstrate the contrary. To the extent "basic" and "typical" parameter types and "obvious" comment choices are within the Examiner's personal knowledge, Applicant reminds the Examiner of the following provision set forth in M.P.E.P. § 2144.03:

[w]hen a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons.

Accordingly, Applicant expressly traverses the Official Notice and request that the Examiner either cite a competent prior art reference in substantiation of the conclusions in the Office Action or else withdraw the rejection. To the extent the Examiner is relying on personal knowledge, Applicant requests the Examiner to provide an affidavit evidencing such knowledge as factually based and legally competent to support his conclusions.

For at least the foregoing reasons, Applicants request withdrawal of the rejection under 35 U.S.C. § 103(a) and the timely allowance of claim 6-11.

Conclusion:

In view of the foregoing, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified above, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 22, 2003

By: 

Frank A. Italiano
Reg. No. 53,056

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com